#12 Petition

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	IFERGAN ET AL.
Appl. No.	:	09/669,492
Filed	:	9/25/00
Title	:	EYEGLASS DEVICE
Grp./A.U.	:	2873
Examiner	:	Director
Attn.	:	
Docket No.	:	64875

Honorable Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

REQUEST TO WITHDRAW THE NOTICE OF ABANDONMENT UNDER 37 C.F.R 1.81

A Notice of Abandonment was mailed on November 12, 2002 with respect to the above identified application for patents. The abandonment indicates that because a response to a non-final office action filed on 11 October 2002 did not contain a signature that it was not a bona fide attempt to reply to the non-final office action. Further, the Examiner indicated that, as the response was filed at the end of the six month statutory period, the amendment could not be entered and no action could be taken to preserve the application and thus issued the Notice of Abandonment. The response was filed at the end of the statutory period and did include a check in payment of the extension of time fees. The response was filed by the undersigned attorney by hand delivery to the Patent Office Receiving Window, 1st floor,

Crystal Plaza 2, on October 11, 2002. A copy of the filing receipt is attached.

Request for reconsideration of the holding of abandonment is respectfully solicited. Under 37 C.F.R. 1.135 (c) when a response filed by an applicant is a bona fide attempt to advance the application to final action and is substantially a complete reply to the non-final action, but where there is some compliance with a requirement which has been inadvertently omitted, applicant may be given a new time period for reply under 37 C.F.R. Section 1.134 to provide the omission.

Submitted with this Request for Reconsideration is a copy of Section 714.03 of the MPEP. Specific example is given where a bona fide attempt is made to respond to a non-final office action and where a signature is inadvertently omitted, a further time period may be granted in which to supply the omission.

The Examiner's statement on the Notice of Abandonment is that because the reply was filed at the end of the statutory period that no further extension could be provided for. However, both the rules and the MP itself specifically address this issue. If there is insufficient time remaining in the initial period, the Examiner may grant a further extension of time under 37 C.F.R. 1.135 (c) in order for the omission to be supplied.

Prior to the Examiner issuing the Notice of Abandonment, the Examiner notified the undersigned attorney that he would have to issue the Notice for lack of signature and he had consulted his

supervisor, Ms. Epps.

A follow-up telephone call was held with the Examiner advising of the provisions of MPEP 714.03 and 37 C.F.R. 1.135(c). A message was also left on the voice mail of Ms. Epps asking for reconsideration based upon the rules and MPEP. However, the formal Notice of Abandonment was subsequently issued.

In view of the foregoing, and as the response filed was a bona fide attempt to address all issues pending in the application as a result of the office action of April 11, 2002, it is believed that the granting of a new time period to supply the omitted signatures is proper under the rules. Therefore, a request to withdraw the abandonment and issue a new time period is respectfully solicited. Also submitted with this response is a copy of the response filed October 11, 2002 in which the omitted signatures are supplied.

Should the receiving official have any questions concerning this request for reconsideration, it is requested that he or she contact the undersigned attorney of record at the telephone number shown below.

Respectfully submitted,

Ralph A. Dowell
Registration No. 26,868
Date: November 26, 2002

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In re U.S. Patent Application of:
Ifergan
Serial No.: 09/669,492

Filed: 09/25/2000

Title: EYEGLASS DEVICE

Art Unit: 2873

Batch No.:

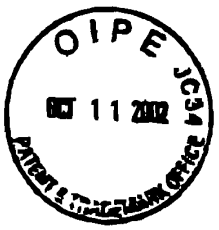
Examiner: Mai, I.

Atty. Docket No.: 13883

THE U.S. PATENT AND TRADEMARK OFFICE STAMP INDICATES DATE OF FILING OF THE FOLLOWING MARKED DOCUMENTS

Doubled checked for completeness ___

PTO/SB/21
PTO/SB/17 with check for $460.00 (3 month extension of time)
Petition for extension of time
Response
Transmittal of Formal Drawings--5 sheets, Figs. 1-10



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(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

In all cases where reply to a requirement is indicated as necessary to further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of an application may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in 37 CFR 1.121(c). The requirements of 37 CFR 1.111(b) must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held not fully responsive for that reason alone. (See 37 CFR 1.112, MPEP § 706.)

The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06.

An amendment which does not comply with the provisions of 37 CFR 1.121(b) and (c) may be held not fully responsive if both a clean version and a marked up version showing changes to the respective parts of the specification/claims are not provided. See MPEP § 714.22.

Replies to requirements to restrict are treated under MPEP § 818.

714.03 Amendments Not Fully Responsive, Action To Be Taken

37 CFR 1.135. Abandonment for failure to reply within time period.

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(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

An examiner may treat an amendment not fully responsive to a non-final Office action by:

(A) accepting the amendment as an adequate reply to the non-final Office action to avoid abandonment under 35 U.S.C. 133 and 37 CFR 1.135;

(B) notifying the applicant that the reply must be completed within the remaining period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)) to avoid abandonment; or

(C) setting a new time period for applicant to complete the reply pursuant to 37 CFR 1.135(c).

The treatment to be given to the amendment depends upon:

(A) whether the amendment is *bona fide*;

(B) whether there is sufficient time for applicant's reply to be filed within the time period for reply to the non-final Office action; and

(C) the nature of the deficiency.

If an amendment submitted after March 1, 2001, fails to comply with 37 CFR 1.121 (as revised on September 8, 2000), the Office will notify applicant by a Notice of Non-Compliant Amendment, that the amendment fails to comply with the requirements of 37 CFR 1.121 and applicant will be given a period of time in which to comply with the rule. If the amendment that fails to comply with the requirements of the rule is a preliminary amendment, the Legal Instruments Examiner (LIE) will send the Notice which sets a time limit of 30 days or one month, whichever is later, for reply. No extensions of time are permitted. Failure to submit a timely reply will result in the application being examined without entry of the preliminary amendment. If the amendment which fails to comply with the requirements of the rule is an amendment after a non-final Office action, the LIE will send the Notice which sets a time limit of 30 days or one month, whichever is later, for reply (37 CFR 1.135). Extensions of time are permitted (37 CFR 1.136(a)). Failure to reply to this Notice will result in abandonment of the application. See MPEP § 714.22 for treatment of non-compliant amendments after final rejection.

Where an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action (and is a *bona fide* attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat every rejection, objection, or requirement), the examiner may simply act on the amendment and issue a new (non-final or final) Office action. The new Office action may simply reiterate the rejection, objection, or requirement not addressed by the amendment (or otherwise indicate that such rejection, objection, or requirement is no longer applicable). This course of action would not be appropriate in instances in which an amendment contains a serious deficiency (e.g., the amendment is unsigned or does not appear to have been filed in reply to the non-final Office action). Where the amendment is *bona fide* but contains a serious omission, the examiner should: A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time p riod for reply; or B) if there is insufficient time remaining, issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). In either event, the examiner should not further examine the application on its merits unless and until the omission is timely supplied.

If a new time period for reply is set pursuant to 37 CFR 1.135(c), applicant must supply the omission within this new time period for reply (or any extensions under 37 CFR 1.136(a) thereof) in order to avoid abandonment of the application. The applicant, however, may file a continuing application during this period (in addition or as an alternative to supplying the omission), and may also file any further reply as permitted under 37 CFR 1.111.

Where there is sufficient time remaining in the period for reply (including extensions under 37 CFR 1.136(a)), the applicant may simply be notified that the omission must be supplied within the remaining time period for reply. This notification should be made, if possible, by telephone, and, when such notification is made by telephone, an interview summary record (see MPEP § 713.04) must be completed and entered into the file of the application to provide a record of such notification. When notification by telephone is not possible, the applicant must be notified in an Office communication that the omission must be supplied within the remaining time period for reply. For example, when an amendment is filed shortly after an Office action has been mailed, and it is apparent that the amendment was not filed in reply to such Office action, the examiner need only notify the applicant (preferably by telephone) that a reply responsive to the Office action must be supplied within the remaining time period for reply to such Office action.

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being "inadvertently omitted." For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a "*bona fide* attempt to advance the application to final action" (37 CFR 1.135(c)), and the examiner is without authority t postpone decision as to abandonment. Likewise, once

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-0843 on November 26, 2002.

Typed or printed name of person signing this certificate:

_____

Ralph A. Dowell, Reg. No. 26,868

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response afer your response has been transmitted by facsimile will only cause further unnecessary delays in processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

FACSIMILE TRANSMITTAL COVER SHEET			
Date:	November 26, 2002	Fax No.: 703-305-0843	
To:	Edward Glick, Art Unit 2870		
Firm/Company	United States Patent & Trademark Office		
Re:	Request to Withdraw the Notice of Abandonment Ifergan et al.		
Your Ref.:	09/669,492	Total No. of Pages including cover sheet	~~18~~ 20 6
From:	( ) Jeanie Morlier, Secretary to Ralph A. Dowell (x) Ralph A. Dowell		

MESSAGE:

PLEASE DELIVER TO EDWARD GLICK UPON RECEIPT.

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